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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,948	03/03/2004	Warren S. Taranow	TNW-10002/29	4130

25006 7590 01/24/2007
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EXAMINER

PATEL, TARLA R

ART UNIT	PAPER NUMBER
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3772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/791,948

Applicant(s)

TARANOW, WARREN S.

Examiner

Tarla R. Patel

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/3/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The Information disclosure statement (IDS) submitted on 06/03/04 is acknowledged by Examiner. The IDS meets the requirements of 37 CFR 1.97 and 1.98 and therefore the references there in have been considered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

Therefore, the brace fitted to the shoulder, as required by claim 13, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be

renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "402" and "602" have both been used to designate sleeve. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant

will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claim 16 is objected to because of the following informalities: Claim 16 the language "encircles a portion of the body above, below, or above and below a wearer's hand; and the orthotic device is an ankle brace". Examiner interprets the orthotic device to be a wrist device, since it is hand, not a leg or foot mentioned in the claim. Applicant has already claimed and ankle device in preceding claim 15. This is believed to be a typographical error.
5. Claim 16 is duplicate claim of the claim 14, wherein applicant is claiming same wrist device. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
7. Claim 13 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 13 requires the sleeve to "encircle a portion of the body above, below, or above and below a wearer's shoulder; and the orthotic device is a shoulder brace". It is unclear how one could use the disclosed device, which is a sleeve shape as a shoulder brace. A sleeve is not capable to be fit around the shoulder because of it having circular shape. Therefore, the specification does not enable the structure and functional recitation as claimed.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how one can use the disclosed device, which is a sleeve shape as a shoulder brace. A sleeve is not capable to be fit around the shoulder because of sleeve having circular shape. Therefore, the specification does not provide the structure and functional requirement.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-3, 5-7, 10-11 and 15-19 rejected under 35 U.S.C. 102(b) as being anticipated by Ruscito (5,573,501).

Ruscito discloses a body-worn implement or orthosis (10) including an evacuable (column 4 lines 63-65) sleeve (12 and 14) or casing encircling an ankle or portion of the body of a wearer and an orthotic or prosthetic (column 8 lines 8-11) attached to the sleeve. A fastener (20) or hinged member is permanently attached to the sleeve. Fastener also can be of hook and loop type fastener (column 4 lines 20-21). The device also further discloses an intermediate layer (11) between the sleeve and the skin of the wearer, which is made by non-woven and porous textured sheet or perforated (column 5 lines 23-25) materials.

Ruscito further disclose the device can be used in knee, hip or spinal, ankle, cervical brace and prosthesis (column 8 lines 3-11). Since the disclosed device is capable of being used with a prosthetic device of a foot,

leg, hand, arm, shoe or boot, since the device is inherently capable of encircling the body in combination with the above prosthetic devices.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ruscito (501) in view of Nauert (6,402,711).

Ruscito substantially disclose the invention, see rejection to claims 1-3, 5-7, 10-11 and 15-19 above; however Ruscito does not disclose that brace has a hinge attached to the sleeve using a male-female mechanical connector. However Nauert discloses knee brace including an operating hinge with an upper (43) or male and lower (49) or female mechanical connector. At the time of the invention was made, it would have been obvious design choice to modify the hinge of Ruscito by substituting the male-female connector as taught by Nauert to provide upper and lower connector, since substitution of parts which provide the same function, in this case that of connecting the sleeve and orthotic via a hinge connection and limiting the angular

displacement of the device, would be within the level of ordinary skill in the art.

14. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruscito (501) in view of Detty (5,472,413).

Ruscito substantially disclose the invention, see rejection to claims 1-3, 5-7, 10-11 and 15-19 above; however Ruscito does not disclose that brace is made of thermal-insulating layer.

However Detty discloses a knee and elbow brace is made of thermal-insulating layer. At the time of the invention was made, it would have been obvious to one skilled in art to make the layer of the Ruscito's device to include the thermal insulating material, which is taught by Detty to maintain an elevated temperature at the joint of the user's body.

15. Claims 12-14,16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruscito (501) in view of Houser (2002/0052568).

Ruscito substantially disclose the invention, see rejection to claims 1-3, 5-7, 10-11 and 15-19 above; however Ruscito does not disclose that brace is made to use on hand including elbow, wrist and shoulder.

However Houser disclose a brace made to use on hand including elbow, wrist and shoulder (abstract). At the time of the invention was made, it

would have been obvious to one skilled in art to modify the device of Ruscito to incorporate the teaching of House to use the device on user's hand including elbow, wrist and shoulder, so device can be easily accessible for all body parts use.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tarla R. Patel whose telephone number is 571-272-3143. The examiner can normally be reached on M-F 6-3.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TP


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1/22/07